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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,957	12/27/2000	Wilson J. Chan	37730-10001	5915
7590	11/05/2004			EXAMINER
Jenner & Block Patent and trademark Docket Clerk One IBM plaza. 41st Floor Chicago, IL 60611			EDELMAN, BRADLEY E	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/748,957	CHAN, WILSON J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bradley Edelman	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 July 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6,8-12,14,15 and 17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-6, 8-12, 14, 15, and 17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

This Office action is in response to Applicant's amendment filed on July 7, 2004.

Claims 1-6, 8-12, 14, 15, and 17 are presented for further examination.

Note: The terms "media switch matrix" and "media interface device control repeater" are not normal terms of art used in either the computer networking or the music industries (Examiner retrieved zero search hits when entering these terms into either Google.com or the U.S. Patent database). The terms appear in the claims, and are defined in the claims only with regard to their function. Therefore, the terms as used in the claims are interpreted only with regard to their function. The specification describes the media switch matrix as including "a plurality of rows of wires 29, a plurality of columns of wires 41, inputs 63 from host computers 18 and processors in media processing hardware and software 22, outputs 53 to host computers 18 and processors in media processing hardware and software 22, and switch controls." See p. 6, lines 30-34. Nonetheless, any computer system includes these features. The "media device control repeater" is described in the specification only in terms of its functionality. Thus, because this description gives no definitive details distinguishing the "media switch matrix" from any other general network computing device, and because the specification describes the "media device control repeater" only with respect to its functionality, only the functions of the "media switch matrix" and "media interface device control repeater," as defined in the claims themselves, are considered.

Thus, the "media switch matrix for routing the media file to said modifying [means]," as claimed in claim 1 is interpreted as "means for routing the media file to said modifying means." Likewise, the "media interface device control repeater for selecting one of a predetermined plurality of modifications to be performed by said modifying means," as claimed in claim 1 is interpreted as "means for selecting one of a predetermined plurality of modifications to be performed by said modifying means."

### ***Claim Objections***

1. The claims are objected to because they were not submitted in correct form. Note that 37 CFR 1.121(c) requires that claim amendment document must include a complete listing of all claims ever presented. In this case, Applicant failed to list claims 7, 13, and 16, which have been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 4, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claims 3, 4, and 9, these claims mention "the media file." Because claim 1 has been amended to recite "a plurality of types of media files," this recitation of

"the media file" in claims 3, 4, and 9 lacks sufficient antecedent basis and is thus unclear.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 8, 9, 11, 12, 14, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sung et al. (U.S. Patent No. 6,423,893).

In considering claim 1, Sung discloses a system for remotely transforming media files, comprising:

A memory (inherent) for storing a plurality of types of media files (types (1) – (4), col. 4, lines 35-37);  
a host computer ("server 15");  
a personal communication device ("client computer 10"), said personal communication device having access to said memory and said personal communication device being adapted to transmit the plurality of types of media files to said host computer (col. 3, lines 60-63; col. 4, lines 31-35; col. 5, lines 4-10, wherein a user at a client creates a file that is one of four types, and stores it at the server);

means accessible to said host computer for modifying the plurality of types of media files (col. 4, lines 34-49, "update" the information using a web browser);

means for storing the modified plurality of types of media files (col. 3, lines 62-63);

means for routing the plurality of types of media files to the modifying means (col. 4, lines 30-45, where each of the types of media files can be routed to the browser), wherein the means uses a chaining process to route the plurality of types of media files to said modifying means (i.e. the files can be modified multiple times, and therefore, modifications can be "chained"; see col. 5, lines 12-16); and

means for selecting one of a predetermined plurality of modifications to be performed by the modifying means (col. 7, lines 46-61; col. 8 lines 13-34, wherein the predetermined modifications include "pick, hammer-on, slide, or other guitar-related techniques," as well as additional modifications, such as chords, measures, volumes, and others).

In considering claim 2, Sung further discloses that the host computer is adapted to transmit information to the personal communication device (col. 5, lines 9-10).

In considering claim 3, as understood, Sung further discloses that the host computer is adapted to receive one of the media files from said personal communication device over the Internet (col. 3, lines 60-63).

In considering claim 5, Sung further discloses that the host computer is adapted to receive a media file that is any of a plurality of predetermined formats (col. 4, lines 35-40, "(1) a solo musical instrument passage; (2) a musical ensemble arrangement; (3) a musical arrangement template; or (4) explanatory text or HTML"; col. 6, lines 11-29, "visual or aural representations," "binary digital audio data or MIDI").

In considering claim 8, Sung further discloses that the means for selecting a modification comprises receiving a control signal from said host computer and means for sending multiple outputs to the modifying means (col. 4, lines 50-65, wherein the server sends preexisting material and meta-data to the client so the client can modify the file).

In considering claim 9, as understood, Sung further discloses that the means for routing one of the media files to the modifying means includes routing the media file through the routing means a plurality of times (col. 5, lines 13-16; "reiterate this process of refining any of these four types of information using the appropriate temporary web application 22 as often as necessary").

In considering claim 11, Sung further discloses that the host computer is adapted to receive a media file that is an audio file (col. 6, lines 11-22, "MIDI" file).

In considering claims 12, Sung further discloses that the host computer is adapted to receive a music notation file (col. 4, lines 35-40).

In considering claim 14, Sung discloses a system for remotely modifying and transforming media files, comprising:

A memory (inherent) for storing a plurality of types of media files (col. 3, lines 62-63; col. 4, lines 30-45);

A personal communication device ("client computer 10"), said device having access to said memory (col. 4, line 17);

A host computer ("server 15"; col. 4, line 18);

A network ("Internet") to allow communication between the host and the personal communication device (col. 4, line 18);

Means accessible to the host computer for transforming the plurality of types of media files (col. 4, lines 30-45);

Means for routing said plurality of types of media files to the transforming means (col. 4, lines 30-45, where each of the types of media files can be routed to the browser), wherein the means uses a chaining process to route the plurality of types of media files to said transforming means (i.e. the files can be modified multiple times, and therefore, modifications can be "chained"; see col. 5, lines 12-16); and

Means for selecting one of a predetermined plurality of transformations to be performed by the transforming means (col. 7, lines 46-61; col. 8 lines 13-34, wherein the predetermined modifications include "pick, hammer-on, slide, or other guitar-related

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techniques," as well as additional modifications, such as chords, measures, volumes, and others).

In considering claim 17, Sung further discloses that the means for selecting a transformation comprises receiving a control signal from said host computer and means for sending multiple outputs to the transforming means (col. 8, lines 34-43).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sung, in view of what was well known in the art at the time the invention was made.

In considering claim 4, although the system taught by Sung discloses the use of the Internet to connect the client and server computers, it fails to disclose the use of a private network. Nonetheless, Examiner takes official notice that the use of a private network for accessing remote data is well known in the networking art. Thus, given such knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of implementing the network system taught by Sung on a private network, to restrict accessibility to only a select few. Therefore, it would have been obvious to implement the system taught by Sung over a private network.

5. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung, in view Applicant's admission of the prior art.

In considering claims, 6 and 15, Sung further fails to disclose that the modifying/transforming means includes a patchbay and media interface device. Nonetheless, the use of patchbay and media interface devices to allow modification or transformation to a media file is well known, as admitted by Applicant in Applicant's application (see p. 6, lines 14-21, describing the use of the Midiman Digipatch 12 x 6 patchbay available from Midiman to make modifications to media files, "as is known to those of ordinary skill in the art"). Therefore, it would have been obvious to a person having ordinary skill in the art to use conventional means to convert the files, to avoid the time and effort required to build an entirely new interface that performs the same function.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sung, in view of Clynes (U.S. Patent No. 5,590,282).

In considering claims 10, Sung fails to disclose that the host computer is adapted to receive a media file that is a video file. Nonetheless, allowing host computers to receive video files is well known in the art, as evidenced by Clynes. In a similar art, Clynes discloses a system for allowing users to remotely modify and create musical files (col. 4, lines 53-67), wherein a host computer that centrally stores the music files is adapted to receive a video file (col. 6, lines 46-48, "video program"). Given the teaching

of Clynes, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing the host device in Sung store video files, to allow the user to more easily view and follow the musical presentation during playback. Therefore, it would have been obvious to include storing video files in the host taught by Sung.

***Response to Arguments***

7. Applicant has argued that the claims as newly amended are not anticipated by either Clynes or Sung. Examiner agrees that Clynes alone does not disclose all of the features of the amended claims, and has withdrawn the Clynes rejections accordingly. However, for the reasons stated in the claim rejections above, Examiner has maintained the 35 USC 102(e) anticipation rejections in view of Sung.

Notably, Sung discloses the newly amended limitations of allowing storage, modification, and transmission of a plurality of types of media files (col. 4, lines 35-45 describes using separate interfaces to change different types of media files, such as HTML, musical instrumental passages, musical arrangement template, etc.). Furthermore, Sung discloses the claimed process if using a chaining process to route the plurality of types of files to the modifying means (col. 5, lines 12-15 describes reiterating the process of modifying the files any number of times, thereby using a progressive “chaining” process in repeatedly sending the files to the modifying means). Thus, Sung discloses all of the features of the claimed invention for the claims rejected under 35 USC 102(e).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE  
October 19, 2004



GLENZON B. BURGESSES  
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